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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,265	12/19/2000	Hiroyuki Yasoshima	57457-015	5780

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EXAMINER

ROSS, JOHN M

ART UNIT PAPER NUMBER

2188

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/739,265

Applicant(s)

YASOSHIMA, HIROYUKI

Examiner

John M Ross

Art Unit

2188

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 1-5, 8, 11-15, 18 and 21, by virtue of being canceled.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 6,7,9,10,16,17,19 and 20.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Continuation of 5. does NOT place the application in condition for allowance because: Applicant suggests that the new grounds of rejection for claim 1 under 35 U.S.C. 103(a) in the prior Office Action was not necessitated by amendment and therefore the finality of the Office Action was premature. Applicant supports this argument by pointing out that the limitations of claim 3 were incorporated into claim 1 and therefore cannot raise any new issues, and the new limitations regarding the "circulating limitation" were explicitly ignored by the Examiner in view of the rejection under the first paragraph of 35 U.S.C. 112 (see Remarks on pages 5 and 6 of amendment). While these facts are indeed true, they were not the basis for the new grounds of rejection. Claim 1 was also amended to change the term "memory array" to "ring buffer" in lines 2 and 5 of claim 1. This latter amendment changed the scope of the claim, thereby necessitating the new grounds of rejection. Therefore, the finality of the previous Office Action is maintained.

In reference to the rejection of claim 6 under 35 U.S.C. 103(a), Applicant argues that the Examiner relies on O'Neill for allegedly disclosing "a system where first and second boundary pointers indicate end points of a first and second buffer area" (see paragraph 4 on page 6 of the amendment). Applicant proceeds to expand on alleged differences between APA and O'Neill in support of a conclusion that APA and O'Neill cannot be combined and that there is no motivation to combine (see pages 7-8 of the amendment).

Examiner is not persuaded. In the rejection of claim 6 O'Neill was not relied upon for the above recited teachings regarding first and second boundary pointers as asserted by Applicant. Rather, APA was relied upon for teaching these limitations (see page 8 of prior Office Action dated 19 March 2004). O'Neill is only relied upon for those teachings not found in APA, particularly the adjusting of boundary pointers in a buffer in accordance with an amount of incoming data, and also where such adjusting is performed dynamically (see pages 8-9 of prior Office Action dated 19 March 2004). Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is provided in the following statement found in the second paragraph on page 9 of the prior Office Action dated 19 March 2004: "... in order to allow the sizes and relative sizes of the buffers to be varied as taught by O'Neill." In other words, O'Neill teaches adjusting boundary pointers of a buffer so that the requirements of the incoming data can be accommodated, and one would be motivated to do so in the system of APA for the same reason.

Mano Padmanabhan
7/27/04

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SUPERVISORY PATENT EXAMINER

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